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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ilan Shemesh

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EXAMINER

HINZE, LEO T

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No. 10/751,575	Applicant(s) SHEMESH, ILAN	
	Examiner Leo T. Hinze	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-27 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Applicant's election with traverse of Invention I in the reply filed on 33 March 2006 is acknowledged. The traversal is on the ground(s) that Inventions I-V are classified in the same class and subclass, as argued on pp. 1-2, and are therefore not distinct inventions. This is not persuasive because classification in a particular class and subclass does not mean that every patent in a subclass is the same invention as every other similarly classified patent.

2. Applicant's election with traverse of Invention I in the reply filed on 33 March 2006 is acknowledged. The traversal is on the ground(s) that Inventions I-V are classified in the same class and subclass, as argued on p. 2, and therefore the search will not be a serious burden on the examiner, because the examiner is required to search only that class and subclass. This is not persuasive because searches for prior art are rarely limited to a search of only one particular subclass. See generally MPEP § 900.

3. Applicant's election with traverse of Invention I in the reply filed on 33 March 2006 is acknowledged. The traversal is on the ground(s) that Inventions I-V each use the same microprocessor, as argued on p. 2, and therefore the claimed subject matter is a single invention. This is not persuasive because the claims are not directed to the structure of a microprocessor that can perform the claimed tests, but instead to that actual function of performing the tests. The individual tests are separate and distinct from each other, requiring, for example, specific computer code, and therefore are separate and distinct inventions.

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4. Applicant's election with traverse of Invention I in the reply filed on 33 March 2006 is acknowledged. The traversal is on the ground(s) that Inventions I-V are not separately useable, as argued on pp. 2-3, and therefore the claimed subject matter is a single invention. This is not persuasive because the tests are separately useable. Each of the claimed tests appears to be useable without requiring the use of a separate claimed test. That the motor test, for example, cannot be used to test industrial motors does not mean that the motor test is not a separate and distinct than, for example, the memory test.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 13, 20-22, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lizzi et al., US 6,323,783 B1 (hereafter Lizzi).

a. Regarding claim 1, Lizzi teaches a clock comprising: a slave clock configured to be coupled to a master clock (“watch,” col. 1, l. 49; “device that receives transmitted coded signals and/or generates and displays time information,” col. 2, ll. 19-20); and means within the slave clock for initiating and performing semi-automatic diagnostic tests on current status and operability of components of the slave clock upon activation of a control device (“cycles through a series of status conditions to determine if any status conditions are satisfied,” col. 1, ll. 54-55),

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and to display results of the diagnostic tests via a display device at the slave clock (“alert the user to a plurality of status conditions,” col. 2, ll. 23-24).

b. Regarding claim 4, Lizzi teaches a clock comprising: a slave clock configured to be coupled to a master clock (“watch,” col. 1, l. 49; “device that receives transmitted coded signals and/or generates and displays time information,” col. 2, ll. 19-20); and means within the slave clock for initiating and performing semi-automatic diagnostic tests on current status and operability of components of the slave clock upon activation of a control device (“cycles through a series of status conditions to determine if any status conditions are satisfied,” col. 1, ll. 54-55), and to display results of the diagnostic tests via a display device at the slave clock (“alert the user to a plurality of status conditions,” col. 2, ll. 23-24); and means for optionally deactivating the diagnostics mode and for returning the slave clock to a normal clock mode (device returns to displaying first information after the diagnostic mode, col. 1, l. 55 - col. 2, l. 3).

c. Regarding claim 13, Lizzi teaches a clock adapted for use in a master/slave clock system including means to perform semi-automatic diagnostic tests on slave clock components, comprising: at least one slave clock configured to be coupled to a master clock (“watch,” col. 1, l. 49; “device that receives transmitted coded signals and/or generates and displays time information,” col. 2, ll. 19-20); a processing unit (34, Fig. 2) and a memory (30, Fig. 2) at the slave clock, the processing unit operating under software control, the processing unit configured to control slave clock functions; whereby the processing unit is further configured to initiate and perform diagnostic tests on current status and operability of components of the slave clock upon activation of a control device (“cycles through a series of status conditions to determine if any

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status conditions are satisfied,” col. 1, ll. 54-55), and to display results of the diagnostic tests via a display device at the slave clock (“alert the user to a plurality of status conditions,” col. 2, ll. 23-24).

d. Regarding claim 20, Lizzi teaches all that is claimed as discussed in the rejection of claim 13 above. Lizzi also teaches wherein the diagnostic tests include determination of presence or absence of electrical power from a power supply (“the battery level is checked,” col. 4, l. 54).

e. Regarding claim 21, Lizzi teaches all that is claimed as discussed in the rejection of claim 13 above. Lizzi also teaches wherein the results of the diagnostic tests are communicated to an operator by way of predetermined numbers of flashes of a visual indicator within a predetermined time interval (messages are displayed as shown in Figs. 4A-4E).

f. Regarding claim 22, Lizzi teaches a method of performing a plurality of diagnostic tests of components of a slave clock of a master/slave clock system, comprising the steps of: determining which diagnostic tests have been selected by an operator-activated control device to be performed at the slave clock (“sequencing through of a plurality of status conditions,” col. 4, ll. 36-37); automatically performing the diagnostic tests selected by an operator to determine current status and operating condition of a plurality of components of the slave clock (“cycles through a series of status conditions to determine if any status conditions are satisfied,” col. 1, ll. 54-55); and automatically communicating results of the diagnostic tests to the operator by a display device (“alert the user to a plurality of status conditions,” col. 2, ll. 23-24).

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g. Regarding claim 24, Lizzi teaches all that is claimed as discussed in the rejection of claim 22 above. Lizzi also teaches wherein the diagnostic tests include determination of presence or absence of electrical power from a power supply ("the battery level is checked," col. 4, l. 54).

h. Regarding claim 27, Lizzi teaches all that is claimed as discussed in the rejection of claim 22 above. Lizzi also teaches wherein the results of the diagnostic tests are communicated to an operator by way of predetermined numbers of flashes of a visual indicator within a predetermined time interval (messages are displayed as shown in Figs. 4A-4E).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5, 14, 19 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizzi in view of Sekiguchi, US 6,751,167 B1 (hereafter Sekiguchi).

a. Regarding claims 2, 5, 14 and 25:

Lizzi teaches all that is claimed as discussed in the rejection of claims 1, 4, 13 and 22 above.

Lizzi does not teach wherein the control device is an operator-activated device located at the slave clock.

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Sekiguchi teaches a time piece with external communications apparatus (col. , ll. 5-10) and diagnostic tests that are controlled by an operator-activated device located on the slave clock (“test mode 121 is selected from the main menu 111 of the timepiece,” col. 21, ll. 39-40).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lizzi wherein the control device is an operator-activated device located at the slave clock as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that this capability would enhance the functionality and utility of the watch, by allowing a user to initiate a test mode at any time to diagnose the operating characteristics of the watch, as opposed to having to wait for the semi-automatic initiation of the diagnostic tests.

b. Regarding claims 19 and 23:

Lizzi teaches all that is claimed as discussed in the rejection of claims 13 and 22 above, including at least three different diagnostic tests (col. 4, l. 52 - col. 5, l. 6).

Lizzi does not teach wherein the control device is an operator-activated device located at the slave clock.

Sekiguchi teaches a time piece with external communications apparatus (col. , ll. 5-10) and diagnostic tests that are controlled by an operator-activated device located on the slave clock (“test mode 121 is selected from the main menu 111 of the timepiece,” col. 21, ll. 39-40).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lizzi wherein the control device is an operator-activated device located at the slave clock as taught by Sekiguchi, because a person having ordinary skill in the art would recognize that this capability would enhance the functionality and utility of the watch,

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by allowing a user to initiate a test mode at any time to diagnose the operating characteristics of the watch, as opposed to having to wait for the semi-automatic initiation of the diagnostic tests.

9. Claims 3, 6, 12, 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizzi in view of Motoyama, US 7,047,293 B2 (hereafter Motoyama).

a. Regarding claims 3, 6, 15 and 26:

Lizzi teaches all that is claimed as discussed in the rejection of claims 1, 4, 13 and 22 above.

Lizzi does not teach wherein the control device is an operator-activated device located at the master clock.

Motoyama teaches performing initiating from a master device diagnostic tests on remote devices (col. 5, ll. 13-50), because it is desirable to monitor the state of remote devices to provide diagnostics, services and maintenance needs (col. 4, ll. 19-22).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lizzi wherein the control device is an operator-activated device located at the master clock, because Motoyama teaches that it is desirable to monitor the state of remote devices to provide diagnostics, services and maintenance needs.

b. Regarding claim 12:

Lizzi teaches a master/slave clock system, comprising: a master clock coupled to at least one slave clock, the master clock located remotely from the at least one slave clock (“watch,” col. 1, l. 49; “device that receives transmitted coded signals and/or generates and displays time information,” col. 2, ll. 19-20); and means within the slave clock for initiating and performing

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semi-automatic diagnostic tests on current status and operability of components of the at least one slave clock ("cycles through a series of status conditions to determine if any status conditions are satisfied," col. 1, ll. 54-55), and to display results of the diagnostic tests via a display device ("alert the user to a plurality of status conditions," col. 2, ll. 23-24).

Lizzi does not teach means within the master clock for initiating and performing semi-automatic diagnostic tests upon activation of a control device at the master clock by an operator.

Motoyama teaches performing initiating from a master device diagnostic tests on remote devices (col. 5, ll. 13-50), because it is desirable to monitor the state of remote devices to provide diagnostics, services and maintenance needs (col. 4, ll. 19-22).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lizzi to include means within the master clock for initiating and performing semi-automatic diagnostic tests upon activation of a control device at the master clock by an operator, because Motoyama teaches that it is desirable to monitor the state of remote devices to provide diagnostics, services and maintenance needs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leo T. Hinze
Patent Examiner
AU 2854
10 June 2006



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